

## **REMARKS**

### **Rejections under 35 U.S.C. § 103**

#### **Rejection over Rothe et al. and Burghardt et al.**

Claims 1-3, 5-6, 10-20, 22, and 25-47 were rejected under 35 U.S.C. § 103(a) over Rothe et al. (U.S. Patent No. 4,738,847) in view of Burghardt et al. (U.S. Patent App. 2002/0001726 A1). The Office Action asserts that Rothe et al. teaches a multi-ply absorbent article containing a virucidal composition in an inner layer, and that Burghardt et al. teaches a multi-ply absorbent article containing an amine-modified polysiloxane in an outer layer.

The rejection of the claims over Rothe et al. and Burghardt et al. is respectfully traversed, as Burghardt is not a proper reference under 35 U.S.C. § 103. As established in the Declaration Pursuant to 37 CFR 1.131, the claimed invention was completed prior to July 29, 1999, which is earlier than the publication date of January 3, 2002 of Burghardt et al. Accordingly, Burghardt is not a proper reference under 35 U.S.C. § 102(a). Moreover, the subject matter of the present application and Burghardt et al. (U.S. Patent App. 2002/0001726 A1) were, at the time the invention of the present application was made, commonly owned by Kimberly-Clark Worldwide, Inc. or subject to an obligation of assign to Kimberly Clark Worldwide, Inc. Accordingly, under 35 U.S.C. § 103(c), Burghardt et al. cannot be used, alone or in combination with other references, in a rejection under 35 U.S.C. § 103. Applicants respectfully request that this rejection be withdrawn.

#### **Rejection over Rothe et al., Burghardt et al., and Roe et al.**

Claim 4 was rejected under 35 U.S.C. § 103(a) over Rothe et al. in view of Burghardt et al., and further in view of Roe et al. The Office Action asserts that Roe et al. teaches a disposable diaper having a top sheet containing a polysiloxane as part of an emollient composition, an inner sheet formed by an absorbent core, and a liquid impervious back sheet. Rothe et al. and Burghardt et al. were asserted as in the rejection of claims 1-3, 5-6, 10-20, 22, and 35-47.

The rejection of the claims over Rothe et al., Burghardt et al., and Roe et al. is respectfully traversed, as Burghardt et al. is not a proper reference under 35 U.S.C. § 103. Claim 4 ultimately depends from Claim 1, which recites an amine-modified polysiloxane applied to an outer ply. Neither Rothe et al nor Roe et al. teach or suggest an amine-modified polysiloxane applied to an outer ply, where the amine-modified polysiloxane has the formula recited in claim 1. Accordingly, claim 4 is not obvious over Rothe et al. in view of Roe et al., as the references do not teach or suggest each and every element of the claim. Applicants respectfully request that this rejection be withdrawn.

### **Rejection over Rothe et al. and Walter et al.**

Claims 35-41 and 46 stand rejected under 35 U.S.C. § 103 in view of Rothe et al. and Walter et al. (U.S. Patent No. 4,950,545 or 5,227,242). The Office Action asserts that the patents issued to Walter et al. ('545 and '242) teach applying a silicone compound to facial tissues to improve softness.

Applicants respectfully point out that the Examiner has not established a *prima facie* case of obviousness under 35 U.S.C. § 103. As noted in MPEP 2142, with reference to *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985):

The initial burden is on the examiner to provide some suggestion of the **desirability** of doing what the inventor has done. [Emphasis added]

Further, it is noted in MPEP 2143.01, with reference to *Ex parte Levengood*, 28 USPQ2d 1300 Bd. Pat. App. & Inter. 1993):

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art" at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is **not sufficient** to establish a *prima facie* case of obviousness

without some **objective reason to combine** the teachings of the references. [Bold emphasis added]

It has further been established that the motivation to combine the teachings of the references may not be extracted from Applicant's own description of the advantages of or the problems solved by the claimed invention. For example, in the decision of *In re Rouffet*, 47 USPQ2d 1453 (Fed. Cir. 1998), the court stated:

...the examiner **must show reasons** that the skilled artisan, confronted with the same problems as the inventor and **with no knowledge of the claimed invention**, would select the elements from the cited prior art references for combination in the manner claimed. [Emphasis added]

The statement in the Office Action that one "having ordinary skill in the art" would be motivated to make a soft and anti-microbial tissue product is thus insufficient to establish a *prima facie* case of obviousness. This statement is not based on any teaching or suggestion in the references to make Applicant's invention, but rather is based on hindsight in view of the properties of the individual inventions as disclosed in the references. Moreover, no evidence is provided of the motivation understood by those skilled in the art, for example in the form of a reference or an affidavit by the Examiner. Thus, until the Examiner provides appropriate references or affidavits showing evidence of a motivation to combine the teachings of Rothe et al. and Walter et al., a *prima facie* case of obviousness has not been presented.

### **Rejection over Rothe et al. and Krzysik et al.**

Claims 35-41 and 46 stand rejected under 35 U.S.C. § 103 in view of Rothe et al. and Krzysik et al. (U.S. Patent No. 6,544,386). The Office Action asserts that the patent issued to Krzysik et al. teaches treating a multi-ply tissue product with a silicone surface additive to provide lubricity.

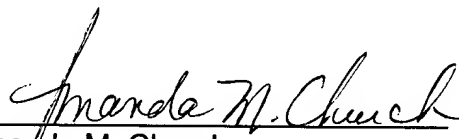
The rejection of the claims over Rothe et al. and Krzysik et al. is respectfully traversed, as Krzysik is not a proper reference under 35 U.S.C. § 103. As established in the Declaration Pursuant to 37 CFR 1.131, the claimed invention was completed prior to

July 29, 1999, which is earlier than the issue date of April 8, 2003 of Krzysik et al. Accordingly, Krzysik is not a proper reference under 35 U.S.C. § 102(a). Moreover, the subject matter of the present application and Krzysik et al. (U.S. Patent No. 6,544,386) were, at the time the invention of the present application was made, commonly owned by Kimberly-Clark Worldwide, Inc. or subject to an obligation of assign to Kimberly Clark Worldwide, Inc. Accordingly, under 35 U.S.C. § 103(c), Krzysik et al. cannot be used, alone or in combination with other references, in a rejection under 35 U.S.C. § 103. Applicants respectfully request that this rejection be withdrawn.

### **SUMMARY**

All grounds raised in the outstanding Office Action for rejecting the application are believed to be overcome or rendered moot based on the remarks above. Thus, it is respectfully requested that all of the presently presented claims are in form for allowance, and such action is requested in due course. Should the Examiner feel a discussion would expedite the prosecution of this application; the Examiner is kindly invited to contact the undersigned.

Respectfully submitted,

  
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